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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,434	05/11/2001	Grace Wong	49854 (72024)	7250

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P.O. BOX 55874
BOSTON, MA 02205

EXAMINER

SPECTOR, LORRAINE

ART UNIT	PAPER NUMBER
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1647

MAIL DATE	DELIVERY MODE
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06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/854,434

Applicant(s)

WONG, GRACE

Examiner

Lorraine Spector, Ph.D.

Art Unit

1647

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

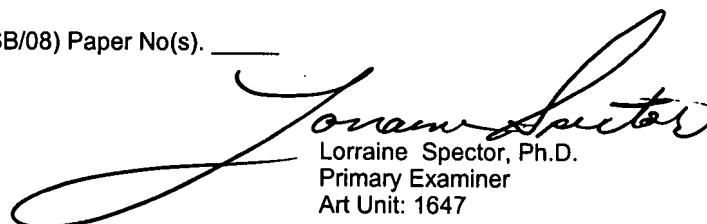
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,5,7 and 12-15.
Claim(s) withdrawn from consideration: 2,4,6 and 8-11.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Lorraine Spector, Ph.D.
Primary Examiner
Art Unit: 1647

Continuation of 5. Applicant's reply has overcome the following rejection(s): issue under 112, first paragraph pertaining to lack of adequate written description of "human genes homologous to said genes" is overcome by deletion of that language.

Continuation of 11. does NOT place the application in condition for allowance because:
Applicants argue that provision of an "IMAGE clone number" is sufficient to describe SEQ ID NOs 1-15. This is not persuasive. The rejection is on the basis of lack of adequate written description, not lack of enablement. First, while each line of Table 1 (for example) has an IMAGE Number, such is not an adequate written description of the gene intended, and certainly does not provide basis for any of SEQ ID NOs 1-15, for which there is no evidence of conception in the specification as originally filed. As stated in the First Office Action on the Merits, the mere mention of a sequence name, such as "ESTs highly similar to..." or IMAGE EST, which is arbitrarily given and contains no specific information, is not sufficient to inform the reader what the actual sequence is. Further, clones may change with time, and may be heterogeneous to start with- the skilled artisan would have no way of knowing what sequence the precise clone used by applicants might have had. Even IF the IMAGE numbers were sufficient to establish written description (which is not conceded), the rejection would be maintained as applicants have not established a chain of custody of the clones demonstrating that SEQ ID NO: 1-15 actually represent the particular sequences used in the specification. Applicants are once again reminded that the Vas-Cath decision clearly teaches that enablement and written description are separate requirements of 35 US 112, second paragraph.
With regard to Y1 cells, the first paragraph of 35 USC §112 requires an adequate written description in the specification as originally filed. There was no identification of Y1 cells in the specification as originally filed. Further, applicants arguments cannot substitute for a written description in the specification; the identifying information provided in the amendment filed 5/20/2003 does not substitute for an adequate written description in the specification. Further, the disclosure of the deposit at page 35 of the specification does not meet the requirements of 35 USC §112, first paragraph as the terms of deposit have not been disclosed. Also, although the cells may have been deposited, there is no description of those cells in the specification, other than the mere name "Y1".